*United States Court of Appeals*

*for the*

*District of Columbia Circuit*

# TRANSCRIPT OF RECORD

JOINT APPENDIX

817

# United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

United States Court of Appeals
For the
District of Columbia Circuit
FILED AUG 15 1957
Joseph W. Stewart
CLERK

No. 13,979

WILLIAM GEISLER
and
WILBRO CORPORATION,
Appellants

v.

ROBERT C. WATSON,
Commissioner of Patents
Appellee

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Robert L. Thiel, Printer
Washington, D. C.
EX 3-0625

# UNITED STATES COURT OF APPEALS

For The District of Columbia Circuit

No. 13,979

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# JOINT APPENDIX

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[Patent Office, Jan. 28, 1950]

## SPECIFICATIONS

This invention relates to paper barrels such as used for shipping dry chemicals and like commodities.

Containers of this type are much stronger than the conventional paper shipping case of rectangular cross section, particularly with respect to its resistance to crushing under a stacking load, but the use of such containers has been heretofore limited by the high cost of manufacture and by the transportation cost of the empty containers.

An important object of the present invention is to provide a container of this type which can be shipped knocked-down and erected at the place of use as expeditiously and cheaply as the conventional fiber board shipping case of like capacity.

A further object of the invention is to provide a container of this type which costs no more than the conventional fiber board shipping case of like capacity but which is much stronger than such shipping cases and can be used for shipping and storing materials for which wooden boxes or barrels have heretofore been used.

A further object of the invention is to provide a container of the class described which is particularly resistant to the absorption of moisture and can therefore be used for shipping and storage under conditions where paper barrels and shipping cases as now constructed can not be used.

Other objects of the invention will appear from the following description and accompanying drawings, wherein

2 Figure 1 is a perspective view of a preferred form of the improved container with a portion cut away;

Fig. 2 is a perspective view of the body of the barrel as shipped flat;

Fig. 3 is a detail view of the scoring used at the folds of the body portion shown in Fig. 2;

Fig. 4 is a perspective view of the rubber strip used for joining the heads of the barrel to the body portion;

Fig. 5 is a detail view of a modified form of side seal for use where a dust-tight joint is required;

Fig. 6 is a perspective view partly in section of a modified head construction;

Fig. 7 is a detail view of the connecting strip used in the barrel shown in Fig. 6;

Fig. 8 is a perspective view of the molded sheet from which the strip shown in Fig. 7 is cut; and

Fig. 9 is a detail view of the side seal used in the construction shown in Fig. 6.

Referring to the drawings, particularly Figs. 1 and 2, 1 indicates the body of the barrel which is formed of a flat rectangular sheet of fiber board of suitable weight. For a barrel 30 inches high with a diameter of 20 inches and to carry a hundred pound load of loose material, 80-point fiber board provides ample strength.

The board forming the body 1 is scored at two points as indicated at 2, with score lines parallel with the axial dimension of the blank, the two scored areas being spaced from each other a distance equal to one-half the circumferential dimension of the blank so that when the blank is folded along the scores the edges of the blank will come together
3 as indicated at 3. In the form of the barrel shown in Figs. 1 and 2 the meeting edges are connected together by a flat strip of molded rubber 4 which is stapled or riveted to the meeting edges of the blank to form a butt joint. The strip 4 is somewhat shorter than the longitudinal dimension of the blank so that when the body portion of the barrel is opened up in circular form and the U-shaped flange of the assembled head fitted over the marginal flanges of the body portion in the manner shown in Fig. 1, the edge of the flange will just contact the top of the strip.

The head of the barrel consists of a flat disk 5 of fiber board and a rubber ring 6 preferably of the shape shown in Fig. 1. As here shown the ring consists of an intermediate portion 7 whose outside diameter is equal to the inside diameter of the body portion when opened up into circular form. At the upper edge of this intermediate portion the ring is bent outwardly and downwardly to provide the U-shaped flange 8 which fits over the marginal edges of the body portion, as previously described. At its lower edge the middle portion 7 of the ring is provided with an inwardly extending flange 9 which underlies the marginal edge of the head 5, the flange 9 and the edge of the head being stapled or riveted together.

The ring 6 is preferably made by extruding the rubber compound through a curved die of the proper shape to form of the extruded material a continuous helix such as shown in Fig. 4. The diameter of the helix is substantially the same as the diameter of the barrel but the rubber is sufficiently flexible for one diameter of helix to make
4 barrels of several dimensions. For example, a rubber strip shaped to a helix of 20 inches diameter would be suitable for barrels of 16 to 24 inches. In forming the hoops from the extruded helix the proper length of rubber is cut off, the two ends brought together and vulcanized into a continuous hoop of a diameter to fit snugly over the marginal edges of the body portion of the barrel.

In order for the body portion to open up to a true circular cross section, the scores along which the sheet is folded are preferably multiple scores such as shown in enlarged detail in Fig. 3. That is, instead of having one deep score which would be required to fold the blank flat on itself, three shallow scores 10 are preferably employed so that they will be readily distended when the barrel heads are fitted into the ends of the body portion. The strip 4, instead of being flat, may be slightly curved to correspond with the curvature of the wall of the barrel when the latter is erected.

In use the barrel is shipped knocked-down to the customer. Preferably the rings 6 are attached to the heads 5 at the factory. The user of the barrel fits one head into the barrel and staples it in place. The barrel is then filled and the other head applied and stapled in place. If desired, one head may be formed with a score line as indicated at 11. With this construction the barrel may be used as a dispensing container by removing the staple or staples by which the portion 12 of the head is attached to the ring.

The barrel shown in Fig. 1 is almost completely water-repellent when made of paper board having the usual wax-impregnated outer surface, for the reason that the edges of the board are protected by the rubber connecting members against the absorption of moisture. The structure is particularly useful for packing commodities which must be stored under varying conditions. Storage warehouses, unless air-conditioned, are usually damp in humid weather, and where the paper of the barrel is in contact with a wet surface it will absorb moisture even though the contacting surface be wax-impregnated. With the barrel of this invention the edges of the ends of the barrel are fully protected by the rubber strip from contact with the floor or wall of the warehouse, and consequently any absorption of moisture must be directly from the air which, as stated above, is substantially prevented by using fiber board having a waxed outer surface.

In Fig. 6 I have shown a modified form of barrel which is somewhat cheaper than the preferred form shown in Fig. 1. As here shown, the rubber strip 20 used for connecting the head of the barrel to the cylindrical wall portion is formed from a Z-shaped strip shown in Fig. 6. This form of barrel is somewhat cheaper than the preferred form for the reason that the rubber may be formed by molding in sheet form instead of by extruding the strip in a continuous length as above described. A suitable rubber compound for molding in sheets may be formed almost entirely of scrap whereas for shaping in an extruding press the rubber stock must be of a better and more expensive grade. The sheet for making the Z-shaped strips is molded in the form shown in Fig. 8 and is then slit along the dotted lines 21 to form the Z-shaped strips with one narrow flange 22 overlying the edge of the body portion of the barrel and a wider flange 23 to which the head of the barrel is attached. The flange 23 is formed with spaced V-shaped incisions 24

so that the strip may be fitted to the edge of the barrel head in the
6 manner shown in Fig. 6.

The barrel head may be attached either to the outside of the flange 23 or to the under side of the flange and in Fig. 6 I have shown the barrel head attached to the under side of the flange.

The flange 22 of the Z-shaped strip may project beyond the edge of the body portion of the barrel a distance equal to the thickness of the strip used for joining the edges of the body blank together in the same manner as in the barrel shown in Fig. 1. I prefer, however, to employ in the barrel shown in Fig. 6 a side joint such as shown in Fig. 9, wherein the edges of the body blank are skived as shown at 25 so that when overlapped they form a flush joint. A reinforcing strip 26 is preferably provided inside the barrel as shown, the overlapped edges of the body blank and the strip being stapled or riveted together. Where it is desired to use the barrel without an inside container for commodities in powder form, the side joint may be advantageously modified in the manner shown in Fig. 5. As indicated at 28 the meeting edges of the blank forming the body portion of the barrel are offset to receive one side of an H-shaped strip of rubber 29 which is fitted over the meeting edges of the blank in the manner shown. This type of side joint is preferably used in lieu of the joint shown in Fig. 2

Barrels constructed in accordance with the present invention may be used not only for the purposes for which paper barrels are now used, but for many purposes where wooden containers are now required. Barrels made of 80-point board are used in lieu of wooden kegs for
7 nails, screws and like items of hardware. Fruit may be shipped and stored in paper barrels such as here shown if holes are provided in the side or heads of the barrel for ventilation. In packing fruit such as apples, a disk of corrugated paper may be placed between each layer of apples or other fruit in the barrel, and when so packed the individual wrapping of the apples or the like is not necessary.

In the foregoing specification I have described the material used for the joining member as "rubber", which term is intended to include in addition to natural rubber, synthetic "rubbers" and compounds having similar physical properties.

In the foregoing description the container has been described as a barrel with the body portion of cylindrical cross section. It will be understood, however, that the construction shown and described may be employed with advantage in making containers of other shapes, for example, hexagonal or octagonal. For such shapes it is only necessary to score the body blank and the appropriate locations for the corners of the body portion and to shape the head to correspond with the cross section of the body portion. Where the rubber used for the adjoining strip is of a composition to be comparatively stiff, it would be advantageous to bend the freshly extruded rubber before vulcanization at points corresponding with the corners of the barrel head, or if a Z-shaped rubber connecting member is employed, to cut the notches in the flanges at points corresponding with the corners of the barrel head. It will be understood that in the appended claims the term "cylindrical" used for defining the shape of the body portion is not intended to limit the claims to a body portion of circular cross section, but covers other shapes of bodies which may be made from a flattened tubular sheet with score lines at appropriate locations.

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## CLAIMS APPEALED

1. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip of angular cross section having one flange attached to the marginal edge of the disk and another flange attached to the marginal edge of the cylindrical body portion.

2. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip having one edge extending transversely from the

middle portion in one direction with the other edge extending transversely from the middle portion in the opposite direction, one edge portion being attached to the marginal edge of the disk, the mid portion being attached to the marginal edge of the cylindrical body and the other edge portion overlying the edge of the cylindrical body.

3. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip having a laterally extending flange at one edge, said flange being attached to the marginal edge of the disk, an oppositely extending flange at the other side of the mid portion with the edge portion of said flange parallel with the mid portion and forming therewith a groove which is fitted over the edge of the cylindrical body portion and attached thereto.

FIG. 1

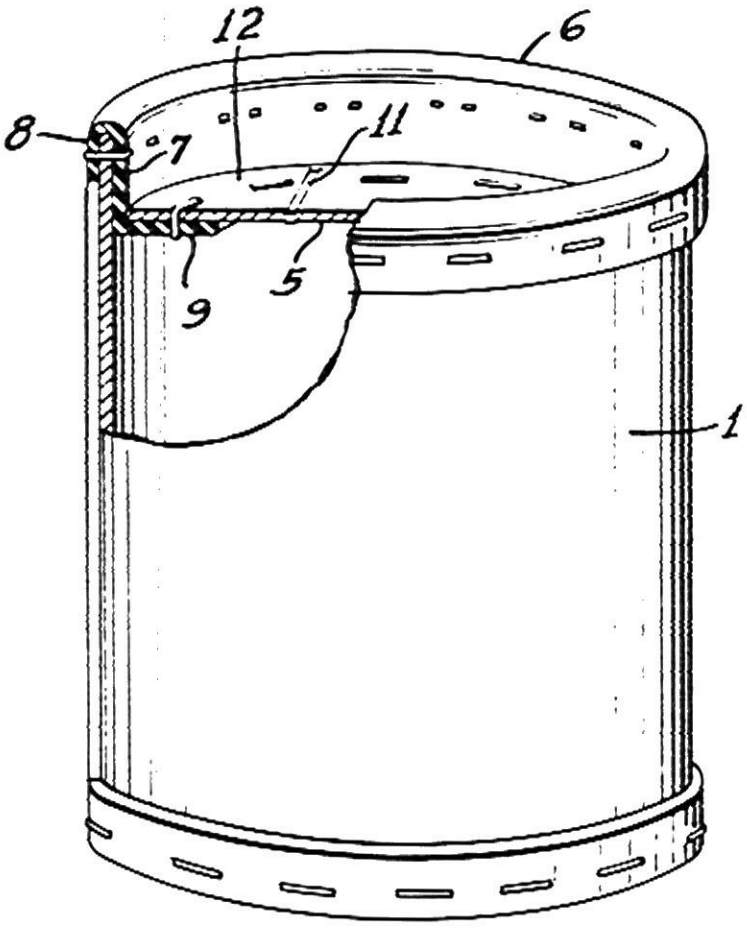


FIG. 2

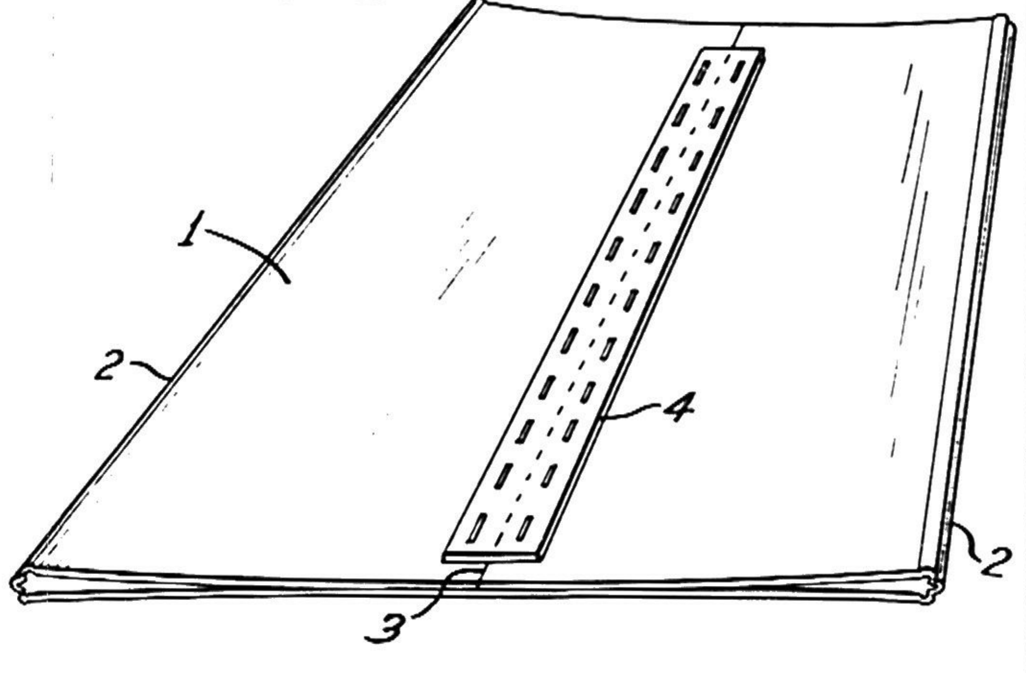


FIG. 3

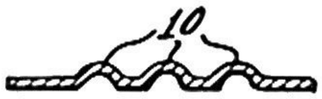


FIG. 4

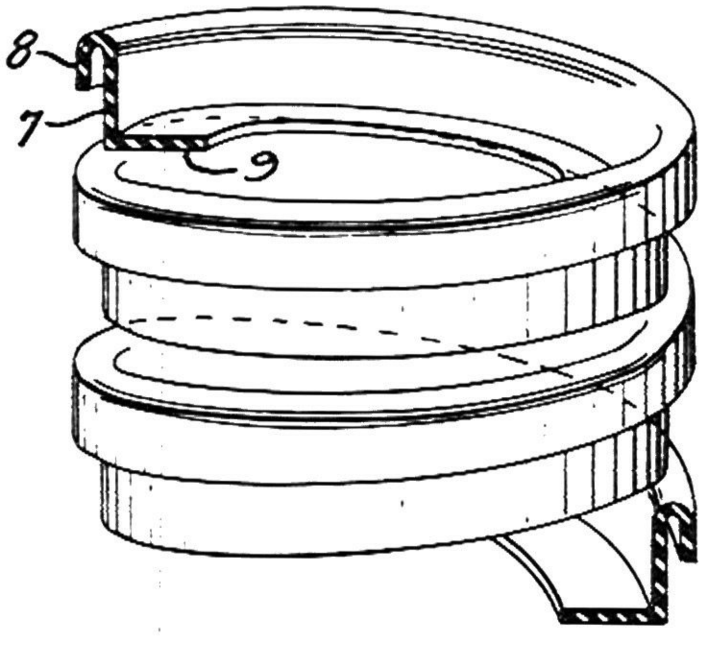


FIG. 6

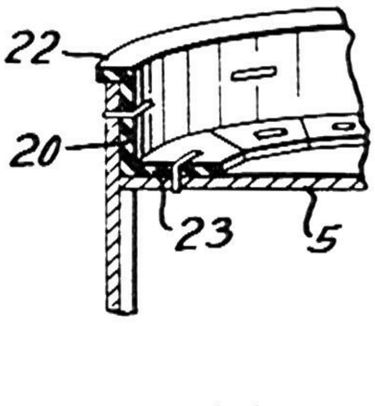


FIG. 7

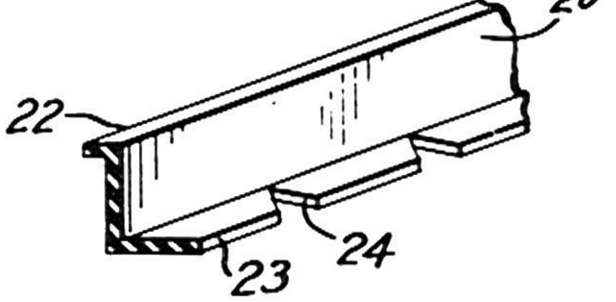


FIG. 5

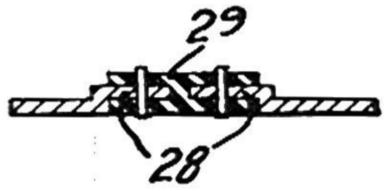


FIG. 8

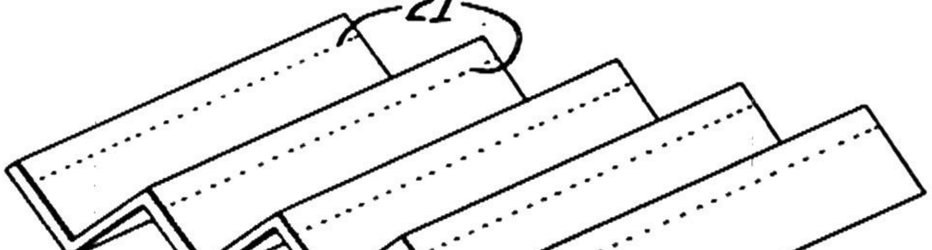
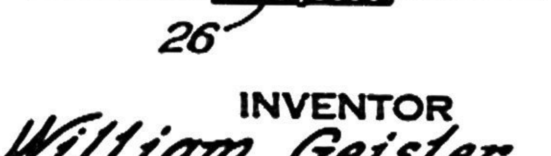


FIG. 9



INVENTOR
William Geisler
BY
Pennie, Edmonds, Morton and Barrows
ATTORNEYS

[Mailed Feb. 27, 1953]

## EXAMINER'S FINAL REJECTION

Responsive to amendment filed June 21, 1952.

Claims 4 to 6 inclusive have been cancelled.

Claims 2 and 3 are rejected as inaccurate and misleading with respect to line 5 of claim 2 and lines 6 and 7 of claim 3. Claim 2 apparently refers to the ring in fig. 6 while claim 3 apparently refers to the ring in fig. 1. Neither ring is disclosed with the cross-sectional configuration recited in said claims.

Claim 1, and, insofar as they are proper, claims 2 and 3 are rejected on the art as unpatentable over the patent to Bliss et al. Bliss et al disclose a paper barrel comprising a cylindrical body, a closure consisting of a fiber board disk and a ring connecting said body and disk, said ring having an annular portion, U shaped in cross-section, engaging the edge of the body and an inwardly extending flange on which the disk may be seated (fig. 4). These claims are anticipated in all patentable respects by the disclosure of Bliss et al. Attention is directed to the specification of Bliss et al, page 2, column 1, lines 13 to 18 where it is indicated that the ring may be made from any suitable material such as fiber board and also same page and column lines 41 to 43 where the preferred form is said to have the radial slots omitted in the inwardly extending flange of said ring. It is not seen that any new or unobvious result will be effected by the mere substitution of rubber for fiberboard in the connecting ring of the device of Bliss et al. Moreover, the concept of providing binding members of rubber is shown to be well known by Boyer.

This rejection is made FINAL.

Acting Examiner

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[Mailed Nov. 20, 1953]

## EXAMINER'S ANSWER TO APPEAL BRIEF

This is an appeal from the examiner's refusal to allow claims 1, 2 and 3. Amendment filed June 26, 1953 has been entered as placing the case in better form for appeal. No claims have been allowed.

A correct copy of the appealed claims appears on pages 1 and 2 of applicant's brief.

The references relied upon are:

| | | |
|---|---|---|
| Bliss | 1,869,929 | Aug. 2, 1932 |
| Boyer | 1,297,994 | Mar. 25, 1919 |
| Jennings | Re. 10,100 | May 2, 1882 |

The alleged invention is adequately described in applicant's brief.

Bliss shows a paper barrel having a cylindrical body and closure disks of fiber board and connection members between the body and closures each having a flange attached to a disk and V-shaped portion fitted over and attached to an edge of the cylindrical body portion. The connection members are stated to be formed of suitable fiberboard material or metal.

Boyer shows a container, a drinking cup, wherein the adjacent edges of the wall members are joined by means of a rubber connecting member with the flanges thereof attached to adjacent edges of the walls. Patent to Jennings shows a barrel having body and ends formed of veneered material with the ends connected to the body by means of a yieldable fabric material attached to the end members and edges of the body member.

Claims 1, 2 and 3 were considered to be unpatentable over Bliss in view of Boyer and Jennings. Bliss discloses a paper barrel over which the claims distinguish only by limitation to the connection being formed of rubber. While the Bliss patent specifically mentions only metal and fiber board as materials for forming the connection, it is indicated that the ring member may be made of any suitable material. In view of the state of the art, as shown by Boyer wherein a connecting member is formed of rubber to provide flexibility, and the well known properties of rubber, it was not seen that the use of rubber in the formation of the Bliss connector would result in such new or unobvious result as would amount to invention. Patent to Jennings, in a similar organization, suggests the desireability of a flexible, cushioning connecting means in the relation set forth.

Respectfully submitted,
Examiner, Division 40

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1 [Mailed Nov. 10, 1954]

UNITED STATES PATENT OFFICE
BOARD OF APPEALS

## DECISION

This is an appeal from the final rejection of claims 1, 2 and 3, which are all of the claims now in the case.

Claim 3 is representative and reads as follows:

> 3. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip having a laterally extending flange at one edge, said flange being attached to the marginal edge of the disk, an oppositely extending flange at the other side of the mid portion with the edge portion of said flange parallel with the mid portion and forming therewith a groove which is fitted over the edge of the cylindrical body portion and attached thereto.

References relied upon are:

2

| | | |
|---|---|---|
| Jennings | Re-10,100 | May 2, 1882 |
| Boyer | 1,297,994 | Mar. 25, 1919 |
| Bliss et al | 1,869,929 | Aug. 2, 1932 |

This application is directed to a paper barrel or drum made from fiberboard wherein the closure members therefor are secured to the body portion by means of U-shaped rubber rings. A flange extends inwardly from the bottom of the inner leg of the rubber ring for the purpose of supporting the closure member.

Claims 1, 2 and 3 were rejected as unpatentable over Bliss et al in view of Boyer and Jennings.

Bliss et al disclose a paper barrel or drum wherein the closure members are secured to the body portion by means of U-shaped rings which have an inwardly extending flange to which the closure member is attached. Bliss et al state that the U-shaped end ring should have a relatively high resistance to wear and be made from suitable fiberboard or other tough fibrous materials, especially in containers of large size. They also indicate that in some instances the U-shaped head ring may be made of metal.

Boyer discloses a collapsible drinking cup having two side walls 5, made of sheet celluloid, which are joined on three sides of their periphery by means of a U-shaped binding made from rubber.

Jennings discloses a barrel having the body portion and end members formed of veneered material with the end members connected to the body portion by means of a yieldable fabric material. Jennings states that by means of this construction he is able to prevent any loss of the contents while admitting of a slight yielding or give to the walls or body portion without straining the closure members as well as furnishing a soft and yielding rim to absorb impacts or blows.

3 The Examiner points out that while the Bliss et al patent specifically mentions only metal and fiberboard as materials for forming the connection between the closure member and the body portion, it is indicated in the patent that the ring member may be formed of any suitable material and it is the Examiner's position, in view of the state of the art and the well-known properties of rubber, that the use of rubber in the formation of the Bliss et al connector would not result in such new or unobvious results as would amount to invention.

Appellant states that his invention consists in substituting a rubber ring or rim for the metal head ring or rim of the Bliss et al patent. He calls attention to an affidavit of record wherein comparative tests of his barrel and the best available similar barrels of the same size using metal rings were made. Appellant also points out that with his construction the rubber ring is distorted along with the paper by the impact of the load but is not injured by the distortion and tends to return after the impact to its original shape and that in yielding with the paper the rubber serves the important function of preventing the paper from being ruptured. Appellant also points out that with a metal-rimmed barrel there will be less flattening of the barrel when dropped, up to a point where the impact is sufficient to permanently deform the metal and, when so permanently deformed, the paper forming the body of the barrel is likewise permanently deformed, thereby weakening the

4 paper and making it liable to rupture. Appellant also points out that the development of the art prior to appellant's invention is always pertinent to the question of whether or not a new step amounts to invention and he points out that the earliest of the patents cited by the Examiner is dated 1882 and from that time to the present there have been many attempts to improve the paper barrel in various ways but that, notwithstanding the familiarity of everyone with the properties of rubber, no one before appellant foresaw that the substitution of rubber rims would greatly enhance the capacity of the paper to withstand the inevitable shocks of commerce.

We have carefully considered appellant's argument but find no reversible error in the Examiner's rejection of the appealed claims as being unpatentable over the prior art.

The appealed claims define over Bliss et al solely by the statement that the connection between the disk or closure member and the body portion is made from rubber, since the rest of the structure called for in the appealed claims is admittedly disclosed by Bliss et al.

Bliss et al state that the head ring or connection between the disk and the body portion is preferably made from fiberboard or other relatively tough fibrous material. Such material would be more resilient than metal but less resilient than rubber and would have substantially the same capacity for recovery after deformation as the body of the drum. We note that the comparative tests set forth in the affidavit were made between appellant's device and a drum container having a metal head ring. We do not consider that these tests are sufficiently conclusive to establish that appellant's device produces any unexpected results. It seems to us that should a person skilled in this art, who was using a fiber container having either a fiber or a metal head ring, be confronted with appellant's problem, i.e., the head ring became indented in use thereby weakening the container, the use of a rubber head ring to solve the problem would be more or less obvious since the resilient properties of rubber and its ability to absorb shock without deformation are almost universally known. To make use of these properties by making the head ring from rubber, instead of fiber or metal, when such change does not produce a new and unobvious result would not require invention. The United States Appliance Corporation v. Beauty Shop Supply Co., Inc., et al., 50 USPQ 40. Scott and Williams, Inc. v. Lasticnit Co. Inc., 83 USPQ 419. Sieberling Rubber Company et al v. The ITS Company, 57 USPQ 235.

We do not think that the disclosures in Jennings or Boyer are particularly pertinent to the issues in this case and they will not be further considered.

The decision of the Examiner is affirmed.

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

[Filed June 19, 1957]

WILLIAM GEISLER and )
WILBRO CORPORATION, )
Plaintiffs, )
v. ) Civil Action No. 82-55
ROBERT C. WATSON, )
Commissioner of Patents, )
Defendant. )

## EXCERPT OF TRANSCRIPT OF PROCEEDINGS

* * * * * *

13 ## OPINION OF THE COURT

THE COURT: Assuming that there are advantages in using rubber and substituting it for fiber or metal, the advantages being in the well-known resiliency of rubber, the Court is of the opinion that giving due weight to the presumption of regularity of the patent office action, there is no reason for differing from its conclusion. The Court is of the opinion, even independently of that, that the substitution of rubber for metal or fiber would be obvious to anyone skilled in the art.

The Court will render judgment for the defendant, dismissing the complaint on the merits.

You may submit findings of fact and conclusions of law.

---

[Filed May 26, 1957]

## FINDING OF FACT

1. William Geisler, applicant for patent, and his assignee, Wilbro Corporation, a corporation of New Jersey, brought this action under 35 U.S.C. 145, to authorize the Commissioner of Patents to issue letters patent to them containing claims 1, 2 and 3 of William Geisler's application for patent entitled "Paper Barrels," Serial No. 141,118, filed January 28, 1950.

2. The Geisler application here in suit relates to a barrel which has a cylindrical body of fiber board, a fiber board disc forming the closure for one end of the body section, and an end ring, or connection between the disc and the body section. This end ring is a rubber strip having an angular cross section with one flange attached to the marginal edge of the closure disk and a second flange attached to the edge of the cylindrical body portion. The second flange is bent back at its edge to form a groove for receiving the edge of the cylindrical body portion.

3. Bliss et al. patent No. 1,869,929, patented August 2, 1932, discloses a drum container made from fiber board and having the same cylindrical body structure, closure disk structure, and end ring structure as the barrel shown in the Geisler application here in suit. The end ring of the Bliss patent, however, is formed from a strip of fiber board material or metal.

4. Assuming that advantages are obtained by the substitution of a rubber head ring for the fiber board or metal head ring in the drum container or barrel of the Bliss et al. patent, these advantages result from flexible or resilient properties of rubber which were well known to those having the ordinary skill of the art relating to paper board barrels or drum containers at the time Geisler devised his paper board barrel.

5. The paper board barrel of the Geisler application having a rubber head ring would have been obvious from the disclosure of the Bliss et al. patent, to a person skilled in the art pertaining to paper board drums or barrels, at the time that the Geisler paper board barrel was devised.

6. Claims 1, 2, and 3 of the Geisler application in suit define no patentable invention over the Bliss et al. patent.

## CONCLUSIONS OF LAW

1. The plaintiffs are not entitled to a patent containing any of the claims 1, 2, or 3 of the Geisler application Serial No. 141,118.

2. The complaint should be dismissed as to all the claims in suit.

March 26, 1957 /s/ Alexander Holtzoff, Judge

[Filed May 26, 1957]

# JUDGMENT

This action came on to be heard at this term, and thereupon upon consideration thereof, it is this 26th day of March, 1957

ADJUDGED that the complaint be and it is hereby dismissed, with costs against plaintiffs.

/s/ Alexander Holtzoff, Judge.

Approved as to Form:

/s/ C. M. Fisher, Attorney for Plaintiffs

Patented Aug. 2, 1932 **1,869,929**

# UNITED STATES PATENT OFFICE

HERBERT R. BLISS AND HOWARD G. ALLEN, OF NIAGARA FALLS, NEW YORK, ASSIGNORS TO H. R. BLISS CO., INC., OF NIAGARA FALLS, NEW YORK, A CORPORATION OF NEW YORK

## DRUM CONTAINER

Application filed May 29, 1929. Serial No. 366,795.

This invention relates to drum containers with special reference to containers of fiber board construction.

While the container contemplated, is referred to herein as a drum container, the invention is concerned with a container essentially round in cross section, while it may be cylindrical or conical. The invention is concerned particularly with the end head construction of such a container and the manner in which it is associated with the body of the drum container. Among the objects of the invention is the provision of an end head construction for drum containers, which is so constructed that it can be secured to the drum as by means of stitches or rivets, or thread or wire sewing, and yet provide a substantially leak-proof container. At the same time, the construction is such as to form a material reinforcement for the end edges of the drum, which is particularly advantageous with large containers, which vary probably, in their handling, will be rolled on their end edges, also stacked on end, and conveyed in upright position on conveying trucks.

In the accompanying drawing:

Fig. 1 is a view of a container constructed in accordance with the invention, partly in cross section and partly in a side elevation.

Fig. 2 is a section taken on line 2—2 of Fig. 1, illustrating how the body of the container may be formed.

Fig. 3 is a view showing a modified form of seam in the body.

Fig. 4 is a sectional view taken through the edge of the container, illustrating a modified type of end head.

Fig. 5 is a section similar to Fig. 4, in illustration of a further form of modified end head.

Fig. 6 is a perspective view of a portion of an end head ring.

Fig. 7 is a sectional view taken through an end head ring at its overlapping ends when said end ring is made from a suitably shaped length of material.

Fig. 8 is a perspective view of the end of a container as shown in Fig. 1.

The body of the container, as illustrated in Fig. 1, is cylindrical and it is composed of a wall 1. The body of the container may be made up in a number of different ways; for example, a single piece of fiber board material may be shaped into cylindrical form with its opposite marginal portions overlapping. The marginal portions may be secured together as by means of the rivets, or wire stitches 2. This forms a vertical seam in the cylinder. The vertical seam may be constructed, as illustrated in Fig. 3, wherein the marginal edges of the cylindrical wall are brought into substantial abutting relation, and a securing strip is provided, which bridges the abutting edges and which is stitched, or riveted to each by means of devices 4. The bridging strip 3 may be placed either inside or outside of the container, and as shown in Fig. 3, it is in the inside. There are at present available, winding machines which provide cylindrical containers by helically wound fibrous material, and the drum or cylinder may be made up in this manner if desirable.

One or both ends of this cylindrical container may be closed by the head now to be described. This end head comprises essentially what may be termed an end head ring 10. This ring is of channel formation, or U-shaped in cross section. The **U** is inverted in the case of the top end of the cylinder. The marginal edges of the cylinder are fitted into the **U** formation so that one leg of the **U**, as illustrated at 11, fits around the outside marginal edge of the cylinder, while the other leg 12 fits within the marginal edge of the cylinder. The bight portion 14 is designed to be urged down in contact with the edges of the container wall in a manner later to be described, so as to form a very tight closure. This end head ring is provided with an inwardly extending flange portion 15, for the purpose of supporting the body of the end head. As shown in Fig. 1, the end head proper is composed of two discs of suitable fiber board or the like 16 and 17. The disk 17 is of a size, preferably, as to snugly fit into the cylindrical container, while the disc 16 is slightly smaller so as to fit within the portions 12 of the end head ring.

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With this construction, the discs 16 and 17 may be secured, and preferably are secured, to the flange 15, as by means of suitable wire stitches or rivets 18, while the end head is held in place to the body of the container, as by means of suitable wire stitches or rivets 19, which extend through the legs of the U and marginal portion of the cylinder. It is, of course, feasible to secure the said parts together by means of sewing with thread or wire, or in some instances, where it is desirable, glue could be used.

The end head ring can be constructed in different ways. For example, it may be stamped out of a sheet of suitable material, and formed into shape by dies or the like, but it is preferable to form it from a strip of suitable fiber board material or metal. In this event, an appropriate length of material is required, and preferably, it is first shaped into the proper cross sectional shape and then bent or spun into circular shape, with its ends overlapping, as illustrated in Fig. 7. The overlapping ends may be secured together as by means of one or more stitches or rivets 20. A problem is presented herein, of the differential between the inner and outer diameters of the flange 15 when the end head ring is made from a strip of material as just described. It is thought to be preferable to form the end head ring by distorting the material in the flange 15; by this is meant that the material may be compressed somewhat near its inner diameter. This may be expedited by softening the flange by means of steam or water treatment. The end head ring can be provided, however, by cutting the same radially, as at 21 (Fig. 6) to permit of slight overlapping of the material adjacent the slots when the same is formed into ring shape. Satisfactory results have been obtained by making the end head ring without the radial slots, and this is preferred.

Varying requirements of a container of this nature are such that different types of heads may be employed in containers designed for different usages. For example, in Fig. 4 the end head of the container is shown as consisting of merely one disc 16*a*, which is placed on the outside of the flange 15 of the end head ring. In Fig. 5 the end head consists of a single disc 17*a*, which is placed on the inside of the flange.

There are a number of advantages to this head formation. One is that a sift-proof end head is provided for a container of the type described. This is accomplished by reason of the fact that disc 17 relatively tightly fits into the drum and also due to the fact that in securing the end head to the drum the same is urged against the drum until the edges thereof tightly abut against the bight portion 14 of the U formation of the end head ring. Thus a double seal is provided. Of course, where the seal need not be so secure, an end head construction such as shown in Fig. 4 may be used. However, a very satisfactory seal is provided by the end of the container abutting into the bight portion of the U of the ring. The end head construction, as shown in Fig. 5 provides for the double seal, yet does not afford the strength of the double head as in Fig. 1. Another advantage is that the head is uniformly positioned, so that a multiplicity of containers of this character are exactly uniform. In other words, the end head of each container is exactly positioned by the end edges thereof abutting against the bight portion of the U. This not only adds to the appearance of the containers, but facilitates handling and stacking of the same.

Preferably, the material used for making the end head ring, is such that has a relatively high resistance to wear, or in other words, of relatively tough fibrous material especially in containers of large size. This is done because containers of this nature are usually stacked on end, and when moved from place to place, are often rolled on edge. Also the end head ring can in some instances, be made of metal where this is desired.

Claims:

1. A fiber board container comprising, a drum-shaped body, an end head ring having a U-shaped formation in cross section and separate from the body, said end head ring being placed onto the end of the body with the bight portion of the U abutting against the edge of the drum body and with the legs of the U lapping the inner and outer sides of the wall of the drum body, a plurality of metallic stitches circumferentially arranged and in spaced relation extending through the legs of the U and marginal portions of the drum wall for securing the end head ring to the drum body, an inwardly projecting flange carried by the end head ring, and a fiber disc-like end head closure member overlapping said flange and metallic stitches securing the same thereto.

2. A fiber board container comprising, a cylindrical container body, a circular end head ring which has a U-shaped formation in cross section, said ring being fitted to the end of the cylindrical container with the bight portion of the U abutting the edge of the container and with the legs of the U lapping outside and inside the container wall, a plurality of circumferentially arranged spaced wire stitches extending through the container wall and legs of the U formation, an inwardly extending flange on the end head ring, a disc member fitting within the container on one side of the flange, and a second disc member disposed on the other side of the flange and metallic holding devices penetrating the flange and discs.

3. A drum-shaped fiber board container comprising a fiber board blank of cylindri-

cal formation with its edges extending from end to end of the cylinder, wire stitches penetrating the blank near said edges for uniting the same, a ring member of fiber board or the like at each end of the cylindrical body, said ring members each being U shaped in cross section and fitted over the edges of the blank with the bight portion thereof substantially abutting the extreme edges of the cylindrical body, a plurality of metallic devices penetrating the legs of each ring member and walls of the body for securing the ring members thereto, each ring member having an inwardly projecting flange extending from the end of one leg member, a fiber board disk at each end of the drum-shaped container, and metallic fastening device penetrating each disk and the adjacent flange.

In testimony whereof we affix our signatures.

HERBERT R. BLISS.
HOWARD G. ALLEN.

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Aug. 2, 1932. **H. R. BLISS ET AL** 1,869,929

DRUM CONTAINER

Filed May 29, 1929

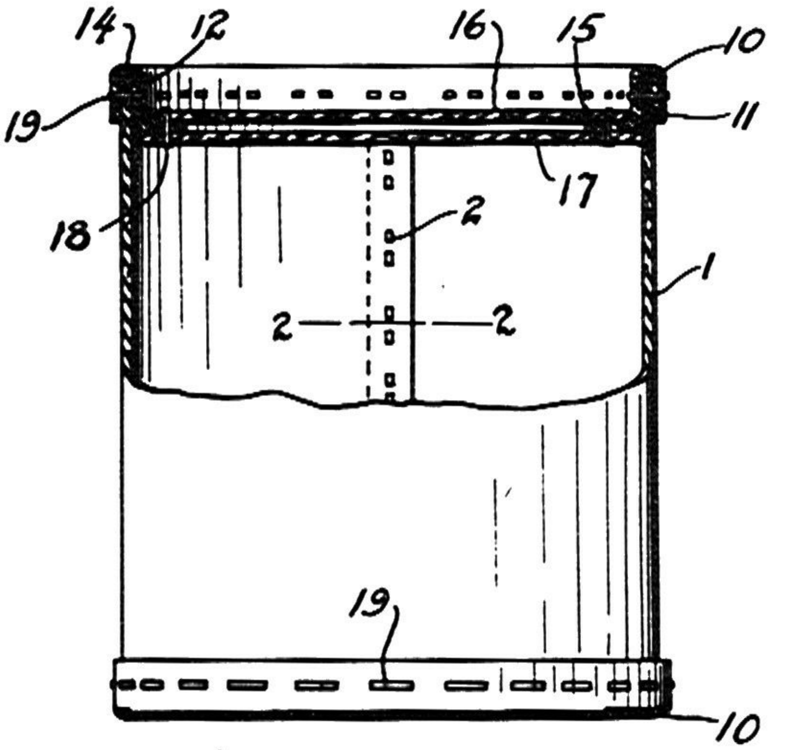

Fig. 1

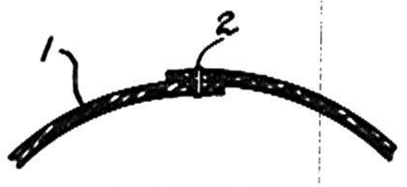

Fig. 2

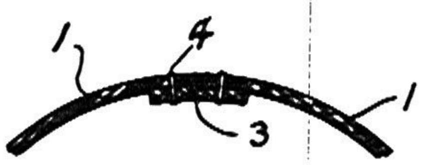

Fig. 3

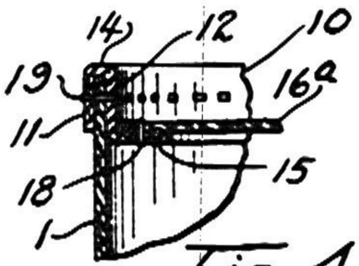

Fig. 4

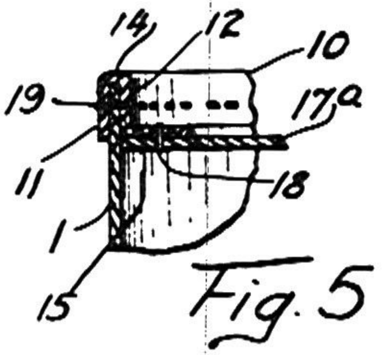

Fig. 5

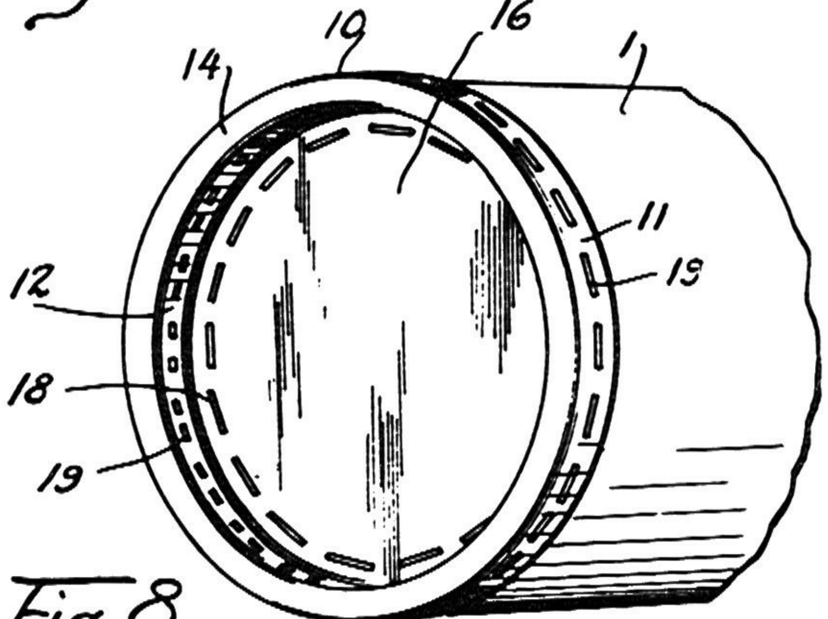

Fig. 8

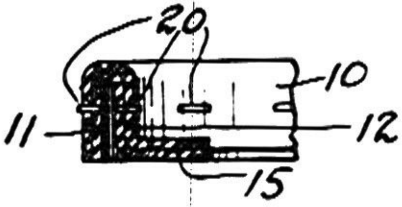

Fig. 7

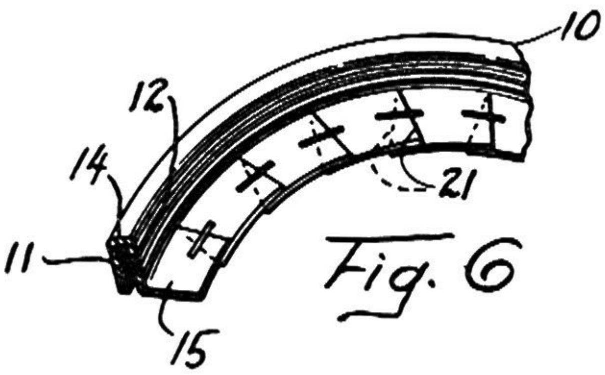

Fig. 6

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BRIEF FOR PLAINTIFFS-APPELLANTS

IN THE

# United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA

United States Court of Appeals
For the
District of Columbia Circuit

FILED AUG 15 1957

Joseph W. Stewart
CLERK

## Appeal No. 13,979

WILLIAM GEISLER and WILBRO CORPORATION,
*Plaintiffs-Appellants*

v.

ROBERT C. WATSON, Commissioner of Patents,
*Defendant-Appellee*

**Appeal from a Judgment of Dismissal of a Civil Action in the United States District Court for the District of Columbia**

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## THE QUESTIONS PRESENTED

1. Was it obvious within the meaning of U.S. Code, Title 35, Sec. 103(a) to substitute rubber rings for the metal and paper board rings used to join the heads and walls of paper barrels, to lessen the rupture of the walls of such barrels from bending and distortion with a resulting *increase* in bending and distortion but a significant decrease in resulting rupture?

2. Was not the Opinion of the District Court that such substitution was "obvious" based solely on wisdom after the event?

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IN THE

# United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA

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*Defendant-Appellee*

---

**Appeal from a Judgment of Dismissal of a Civil Action in the United States District Court for the District of Columbia**

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## BRIEF FOR PLAINTIFFS-APPELLANTS

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### JURISDICTIONAL STATEMENT

This is an appeal from the final judgment of the District Court for the District of Columbia in an action against the Commissioner of Patents under U.S. Code, Title 35, Sec. 145. This Court has jurisdiction of this appeal under the provisions of U.S. Code, Title 28, Sec. 1291.

### STATUTE INVOLVED

U.S. Code, Title 35, Sec. 103. Conditions for patentability; non-obvious subject matter.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

## STATEMENT OF THE CASE

The plaintiffs seek an order directing the Commissioner of Patents to issue to them a patent on their application Serial No. 141,118, filed January 28, 1950, relating to improvements in Paper Board Barrels.

The case was tried on March 18, 1957, and, following an Opinion from the bench at the conclusion of the trial (App. 15) Findings of Fact and Conclusions of Law and a Judgment of Dismissal were entered on March 26, 1957. The case has not been reported.

No evidence was presented at the trial other than the certain portions of the Patent Office proceedings including the specification (App. 1) the rejected claims (App. 6), the decision of the Board of Appeals of the Patent Office affirming the Examiner's rejection of the claims, (App. 11), and a copy of the patent No. 1,869,929 upon which the Patent Office rejection was based (App. 18). The Court's Opinion appears in the Appendix (App. 15) as do also the Findings of Fact and Conclusions of Law (App. 15) and the Judgment of Dismissal (App. 17).

It was the intention of the plaintiffs to have the inventor testify at the trial as to his experience with paper board barrels in shipping commodities of different kinds, and also with regard to certain tests with barrels embodying the claimed invention in comparison with barrels constructed in accordance with the prior art. Two or three days before the time set for the trial, however, he was subpoenaed as a witness in a Civil action pending in the Supreme Court of the State of New York and was therefore unable to appear in this case. A motion was made for a continuance in the District Court, but the motion was denied, and consequently no additional evidence could be presented to the District Court.

The District Court permitted counsel for plaintiffs to state the nature and results of the tests above referred to, and it may be that this Court will also permit counsel at the argument to briefly summarize these tests.

Barrels made of paper board have been widely used for many years for the shipment of non-liquid commodities such, for example, as bottle caps and similar small metal articles, soap powders, borax and the like. These barrels are made of sheets of heavy paper board. For a barrel 20 inches in height and 16 inches in diameter 100-point paper board is used, which means that the board is one-tenth of an inch thick. The edges of the sheet of board are brought together to form a cylinder with the edges overlapped and riveted or stitched together. The ends of the cylinder are closed either with disks of similar board or of ply-wood and the ends of the barrel are attached to the cylindrical body portion by rings of metal. The Bliss patent on which the claims were rejected in the Patent Office discloses a conventional barrel of this kind, which patent also states that rings of paper board may be used in lieu of the metal rings for attaching the parts together.

The invention for which a patent is sought consists in the substitution in a barrel such as described in the Bliss patent of a rubber ring for the metal or paper board rings recited in the patent, the rubber rings being of appropriate cross section to not only unite the heads to the side walls of the barrel but also to cover the ends of the side walls of the barrel which project beyond the head so as to protect the paper against the absorption of water when the barrels are supported on a wet floor.

The appealed claims read as follows:

> 1. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip of angular cross section having one flange attached to the marginal edge of the disk and another flange attached to the marginal edge of the cylindrical body portion.
>
> 2. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip having one edge extending transversely from the middle portion in one direction with the other edge extending transversely from the middle portion in the opposite direction, one edge portion being attached to the marginal edge of the disk, the mid portion being attached to the marginal edge of the cylindrical body and the other edge portion overlying the edge of the cylindrical body.
>
> 3. A paper barrel comprising a cylindrical body portion of fiber board, a fiber board disk forming the closure of one end of the body portion and a connection between the disk and the body portion comprising a rubber strip having a laterally extending flange at one edge, said flange being attached to the marginal edge of the disk, an oppositely extending flange at the other side of the mid portion with the edge portion of said flange parallel with the mid portion and forming therewith a groove which is fitted over the edge of the cylindrical body portion and attached thereto.

The Trial Judge in his opinion delivered from the bench held the claims unpatentable on the following stated grounds:

> "Assuming that there are advantages in using rubber and substituting it for fiber or metal, the advantages being in the well-known resiliency of rubber, the Court is of the opinion that giving due weight to the presumption of regularity of the patent office action,

> there is no reason for differing from its conclusion. The Court is of the opinion, even independently of that, that the substitution of rubber for metal or fiber would be obvious to anyone skilled in the art." (Opinion, App. 15)

It is plaintiffs' position that there was nothing in the prior art which in any way suggested that a connecting ring having the well known physical characteristics of rubber would be useful as a substitute for the metal and paper board rings of the prior art, and that the Court's conclusion that the substitution of rubber for metal is obvious, is wisdom after the event.

## SUMMARY OF ARGUMENT

*1. The inventive concept was not that the substitution of rubber for the metal and paper board rings of the prior art would supply greater resilience where resilience was indicated.*

*2. The inventive concept was that although the distortion and bending of the walls of the paper barrels would be greater with rubber rings substituted for the metal and paper board rings of the prior art, the resulting rupture of the walls from such bending and distortion would be significantly lessened.*

*3. The conclusion of the District Court that the substitution of rubber rings for metal or paper board rings was "obvious" is based on wisdom after the event.*

## ARGUMENT

The inventive concept was not in the selection of rubber as a material for the fabrication of parts where resilience was known to be advantageous, but in the recognition that the *rubber* ring would provide a connection between the parts of the barrel which would *permit the distortion* of the paper barrel wall without breakage to a greater extent than was possible when the parts were connected by the metal and fiberboard rings of the prior art.

Resilience is not a desired characteristic of paper barrels. Paper barrels are substitutes for metal drums and wooden barrels and the efforts of the prior art have heretofore been to construct the barrel so that it would retain its shape and resist distortion and bending under the impacts and pressures encountered in shipping and handling. It was the inventor's conception that the *paper* would function differently with the rubber ring and that although such a barrel might reach its destination somewhat lopsided but still intact under conditions which would not distort the barrels of the prior art, it would also remain intact under conditions which would rupture the paper walls of the conventional barrel.

As pointed out in the specification the paper board making up the body of the barrel is not protected against distortion to a greater extent with the rubber connecting rings that it is with the metal and paperboard rings of the prior art. On the contrary, the barrel with the rubber connecting rings is distorted to a *greater extent* by the same impact than the barrels of the prior art, but with the rubber rings the barrel recovers from the distortion without permanent injury, whereas with the metal or paperboard rings the barrel will be distorted to a *lesser degree* with the same impact, but this lesser degree of distortion will result in a permanent rupture of the paper board of the barrel.

Viewed *after the event* the reason for this difference may seem fairly obvious. With the rubber ring fastened securely by stitches to the wall of the barrel and the edge of the barrel head the rubber ring bends with the paper when the barrel is dropped or otherwise subjected to impact and pressure. Also the paper bends with the rubber and the shape the combined paper and rubber takes when subjected to the impact or pressure depends on the characteristics of the two materials. The paper tends to bend at a sharp angle with consequent rupture, but it is very difficult to bend rubber at a sharp angle and consequently the combined rubber and paper will bend in the form of a curve rather than a sharp angle and consequently the paper is not ruptured.

There are many cases dealing with the question of the patentability of new articles of manufacture wherein the novelty lies in the substitution of one material for another. (*Ex parte Mitchell,* 69 USPQ 183, 184, *Ex parte Clark,* 69 USPQ 356, *Ex parte Aram,* 346 O.G. 783, *In re Earle et al.,* 41 USPQ 24, *Dewey & Almy Chemical Co.* v. *Mimex Co. Inc.,* 52 USPQ 138, 124 F.2d 988, C.C.A. 2, and *George Frost Co.* v. *Cohn,* 19 F.2d 505, 507.) We believe these cases represent the weight of authority on this question and that the following statement from *Dewey & Almy Chemical Co.* v. *Mimex Co. Inc., supra,* summarized the law as construed by the courts prior to the enactment of the new Patent Act, and correctly states the test of invention in this class of cases as now defined by the language of the statute:

> "We do not mean that the mere substitution of materials cannot be an invention. Smith v. Goodyear Dental Co., 93 U.S. 486; Akme Flue v. Aluminite Flexible Flue Co., 27 F. 2d 736 (C.C.A. 2); United Shoe Machinery Corp. v. Ferree, 64 F. 2d 101 [7 USPQ 402] (C.C.A. 2); Samson-United Corp. v. Sears Roebuck Co., 103 F. 2d 312 [41 USPQ 519] (C.C.A. 2). When for example a material has been available for many years, and no one has thought to use it in a new physical combination to answer a need equally old, there is as much reason for treating its selection as evidence of invention as the selection of any other element; and it is unfortunate that loose statements, thrown out arguendo, have at times seemed to give to the substitution of new materials a different standing from that of other combinations—often indeed the question has been quite unnecessarily confused with that of a new use." (124 F.2d 990)

In the plaintiffs' barrel the rubber rings serve as do the metal fiber board rings of the Bliss patent to securely join the heads to the body of the barrel. But the rubber rings serve the additional and important function of preventing rupture of the paper board when subjected to a force sufficient to distort the shape of the barrel.

The rubber ring is distorted along with the paper by the impact of the load but is not injured by the distortion and tends to return after the impact to its original shape. In yielding with the paper, the rubber serves the important function of preventing the paper from being ruptured. The paper is flexible like the rubber; it also has a high tensile strength but unlike the rubber, its capacity for recovery is limited. If bent beyond a certain point by external force, the paper suffers what is known to the trade as a "crease fold" which results in a permanent weakening and deformation of the paper. Otherwise stated, when one edge of a sheet of heavy paper board such as barrels are made of, is tightly held and force is applied to the other edge of the board, the sheet tends to bend in a sharp corner at the weakest point in the sheet, but a rubber sheet will tend to bend in a curve of wide radius so that no point in the sheet is subjected to a strain sufficient to rupture the material. When the combined rubber and paper rims of the barrel are subjected to severe impacts, the rubber prevents the paper from bending sharply and becoming ruptured so that when the barrel is dropped, although its side may be flattened to a considerable extent, it will not break at any point and when set on end again will to a large extent return to its original cylindrical form.

With a barrel having a stiff rim of metal or other material, there will be less flattening of the barrel when dropped, up to a point where the impact is sufficient to permanently deform the rim. When so permanently deformed, the paper forming the body of the barrel is likewise permanently deformed, thereby weakening the paper and making it liable to rupture.

In support of its conclusion that the substitution of rubber for the metal or fiber board of the prior art would be "obvious", the District Court said:

> "It seems to us that should a person skilled in this art, who was using a fiber container having either a fiber or a metal head ring, be confronted with appellant's problem, i.e., the head ring became indented in use thereby weakening the container, the use of a rubber head ring to solve the problem would be more or less obvious since the resilient properties of rubber and its ability to absorb shock without deformation are almost universally known."

While the properties of *rubber* are well known no one could foresee that these properties in the *rubber* would permit the *paper* to be distorted without injury to the same extent as invariably resulted in rupture in the prior art barrels.

The conclusion of the District is clearly based on wisdom after the event.

In retrospect it may be said that if these properties of rubber were known, it would be obvious to anyone skilled in the art to substitute for the prior art rims the applicant's rubber rims. But as has been pointed out time and again by the Supreme Court and other courts in determining the question of the presence or lack of invention, the *ex post facto* wisdom of the bystander is not the test.

> "We think this case is one of that category of inventions which, when viewed after disclosure and explanation by applicant, seem simple and such as should have been obvious to those in the field. Yet this does not necessarily negative invention or patentability. Goodyear Tire & Rubber Co. Inc., et al. v. Ray-O-Vac Company, 321 U.S. 275 [60 USPQ 386]; In re DeLancey, 34 C.C.P.A. (Patents) 849, 159 F.2d 737, 72 USPQ 477. Indeed, simplicity may even be some evidence of invention. Baldwin-Bouthwark Corporation v. Tinius Olsen Testing Mach. Co. et al., 88 F.2d 910 [32 USPQ 336]. Moreover, the conception of doing a thing, the

> result of which is new and useful, must be considered along with the actual steps of doing it in considering the presence or absence of patentability." In re Osplack, 93 USPQ 308, 39 C.C.P.A. 932, 195 F.2d 921.

The development of the prior art prior to the plaintiffs' invention is always pertinent to the question of whether or not the new step amounts to invention. The art cited by the Examiner in the prosecution of the application gives a fair picture of the many years of the paper barrel has attracted the attention of inventors. The earliest of these patents is Jennings, Re 10, 100, May 2, 1882. From the time of this patent to the present, as shown by the various citations, there have been many attempts to improve the paper barrel in various ways, but notwithstanding the familiarity of everyone with the properties of rubber as used in automobile tires and in many other items during the 70 years since the Jennings patent no one before the applicant foresaw that the substitution of rubber rims would so greatly enhance the capacity of the paper to withstand the inevitable shocks of commerce.

## CONCLUSION

We submit that the Judgment of the lower Court dismissing the complaint should be reversed and an order issued authorizing the Commissioner of Patents to grant plaintiff's patent with the claims here presented.

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W. Brown Morton
*Attorneys for Plaintiffs-Appellants*

New York, N.Y.
August 15, 1957.

## BRIEF FOR APPELLEE

# United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 13,979

WILLIAM GEISLER AND
WILBRO CORPORATION, APPELLANTS

*v.*

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
APPELLEE

**Appeal from the Judgment of the United States District Court for the District of Columbia**

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United States Court of Appeals
For the
District of Columbia Circuit

FILED SEP - 9 1957

Joseph W. Stewart

## STATEMENT OF QUESTIONS PRESENTED

In the opinion of appellee questions presented by this appeal are:

(1) Whether plaintiff can prevail in a civil action brought under the provisions of 35 U.S.C. 145 when they adduce no testimony to support their contention that their application claims are patentable over a prior patent, they fail to make of record a copy of an affidavit which they filed in the Patent Office as evidence of the asserted superiority of their claimed paper barrels over certain prior art paper barrels, and they offer to the District Court only their counsel's interpretation of the tests reported in this affidavit.

(2) Whether the appellants' assertion that a novel and unexpected function resulted from the claimed substitution of a rubber end ring for the fiber or metal end ring in a prior art fiber board barrel provides basis for the reversal of the District Court's ruling that no invention was involved in such a substitution, when no evidence is offered to support the assertion.

(3) Whether the substitution of rubber, with widely known properties of resilience and flexibility, for fiber or metal as the material of the end ring of a fiber board barrel would be unobvious to a person of ordinary skill in the art, if it be assumed that a rubber end ring, because of these properties, has certain advantages in reducing permanent damage from impact.

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# United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

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Appeal No. 13,979

WILLIAM GEISLER AND
WILBRO CORPORATION, APPELLANTS

*v.*

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
APPELLEE

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**Appeal from the Judgment of the United States District Court for the District of Columbia**

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## BRIEF FOR THE COMMISSIONER OF PATENTS

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## INTRODUCTION

This is an appeal by William Geisler and Wilbro Corporation from the judgment (J.A. 17) of the United States District Court for the District of Columbia dismissing their complaint in an action under Section 145, Title 35, of the United States Code, in which appellant sought to have that court authorize the issuance to them of a patent containing claims 1, 2, and 3 of the application of William

Geisler, entitled "Paper Barrels," Serial No. 141,118, filed on January 28, 1950. Wilbro Corporation is the assignee of the application.

The Patent Office examiner (J.A. 9, 10), the Patent Office Board of Appeals (J.A. 11), and the District Court (J.A. 15) concurred in rejecting the enumerated claims 1, 2, and 3, which are all the claims in the application, on the ground that they define no patentable invention over the United States patent to *Bliss et al.*, No. 1,869,929, granted August 2, 1932.

## COUNTER STATEMENT OF THE CASE

The Geisler application (J.A. 1), here in suit, is directed to a "paper" barrel which has a cylindrical body of fiber board, a fiber board disc forming a closure for one end of the cylinder, and an "end ring" or rim which connects the disc to the cylinder wall.

This end ring, which is shown in the applicant's drawings (J.A. 8) as *6* in Figure 1 and *20* in Figure 6, is formed from a strip of rubber and has one angular portion attached at a number of points to the end disc and another angular portion similarly attached to the cylindrical body. As described in the specification (J.A. 1) the appellants' barrel has the advantages that it can be shipped knocked down, that it is stronger than conventional fiber board shipping cases although it costs no more, and that it is particularly resistant to the absorption of moisture.

The Bliss patent No. 1,869,929, over which the application claims were rejected as unpatentable, is directed to a "drum container" of fiber board which, as the patent drawings (J.A., last unnumbered page) illustrate, has the same essential structure as that shown in the application. The patent specification (J.A., following 18), however, describes the end head ring (patent, page 2, lines 13 to 18) as being made "from a strip of suitable fiber board material or metal" or (patent, page 2 lines 83 to 87) from a material which "has a relatively high resistance to wear, or in other words, of relatively tough fibrous material especially in containers of large size."

The decision of the Board of Appeals noted (J.A. 12 and 13) that appellant had submitted an affidavit wherein comparative tests were reported between appellants' barrel and "the best available similar barrels of the same size using metal rings" and that appellant had asserted that in his paper barrel, which has a rubber end ring, but not in a paper barrel with a metal end ring, the ring is distorted along with the paper by the impact of a load and is not injured by the distortion and tends to return after impact to its original shape and that in so yielding with the paper the rubber ring prevents the paper from rupturing. The Board, however, held (J.A. 14) that it did not consider the tests reported in the appellant's affidavit to be "sufficiently conclusive to establish that appellant's device produces any unexpected results." The Board concluded, therefore, with the following ruling:

> "It seems to us that should a person skilled in this art, who was using a fiber container having either a fiber or a metal head ring, be con-

> fronted with appellant's problem, i. e., the head ring became indented in use thereby weakening the container, the use of a rubber head ring to solve the problem would be more or less obvious since the resilient properties of rubber and its ability to absorb shock without deformation are almost universally known. To make use of these properties by making the head ring from rubber, instead of fiber or metal, when such change does not produce a new and unobvious result would not require invention."

The appellants as plaintiffs in the civil action made of record a certified copy of the Geisler specification. The application drawing, a copy of the Bliss patent, and the rulings of the examiner and Board were placed in evidence for the Commissioner of Patents. The affidavit which was considered by the Board was not made of record by the appellants but in appellants' brief (page 3, first complete paragraph) a suggestion is made that the Court permit counsel for the appellants "to briefly summarize these tests."

## SUMMARY OF ARGUMENT

1. In order for the appellants to prevail, they must establish that the concurring decisions of the Patent Office and the District Court are clearly erroneous or inconsistent with the evidence. If appellants had presented the same evidence before the Board of Appeals and the District Court, the finding by the Patent Office of lack of invention would have assumed "well nigh dominating importance." Since the appellants rely only on their own interpretation of evidence which was before the Patent Office but not

before the trial court, the Board's finding would seem, by appellate standards, to be an insurmountable barrier to a decision in their favor.

2. The appellants' present assertion that the use of a rubber end ring on a paper barrel gives certain advantages because the rubber ring is distorted along with the paper and returns to its original shape after distortion is not based on any evidence of record in this appeal and is not made in the specification of the Geisler application. No basis exists, therefore, for a determination that these advantages would render the application claims patentable over the paper barrel of the Bliss patent.

3. If the appellants' assertions of the advantages flowing from the use of a rubber end ring on a paper barrel were taken at face value, these assertions would establish that these advantages resulted from the properties of flexibility and resiliency possessed by rubber. These properties are so well known that they have been the occasion of judicial comments. Therefore, the resistance to permanent distortion by impact which is obtained by rubber would render the use of rubber an obvious expedient. The record does not show that the substitution of rubber for fiber or metal solved any long standing problem. There was no evidence that an acute problem existed and no evidence of the extent to which a problem, if it existed, has been solved by appellants' barrel.

## ARGUMENT

1. The appellants' failure to adduce at trial even the same quantum of evidence as that presented before the Patent Office would seem to raise a substantial obstacle to the appellants prevailing on appeal. The appellants filed with the Patent Office, as the Board noted (J.A. 13 and 14), an affidavit purporting to show tests comparing paper barrels with rubber end rings with "the best obtainable similar barrels." However, this affidavit, although referred to in oral argument (Appellants' Brief, page 3), was not offered for the trial court's consideration and is not in the record on appeal although appellants' brief (page 3, first full paragraph) suggests that counsel for the appellants should be permitted to "summarize" the results of the tests at the argument of the appeal. The appellee, Commissioner of Patents, does not consent to the departure from the rules of appellate procedure which the appellants' suggestion involves. It is apparent that the appellants' suggestion, if accepted, would, *inter alia*, deprive the appellee of the right of cross-examination.

The decisions with respect to civil actions under 35 U.S.C. 145, or its predecessor, Section 4915, Revised Statutes, demonstrate that a plaintiff in such a civil action must, in order to prevail, show that the decision of the Patent Office is clearly in error or not reasonable on the evidence. *Abbott* v. *Coe*, 71 App. D.C. 195, 109 F.2d 449; *Radtke Patents Corporation* v. *Coe*, 74 App. D.C. 251, 122 F.2d 937; *Standard Oil Development Co.* v. *Marzall*, 86 U.S.

App. D.C. 210, 181 F.2d 280; *Lebold et al.* v. *Marzall*, 91 U.S. App. D.C. 53, 197 F.2d 209.

In a situation where the evidence before the District Court is the same as that before the Patent Office the Patent Office ruling should normally be followed. *Esso Standard Oil Company* v. *Sun Oil Company*, 97 U.S. App. D.C. 154, 159, 229 F.2d 37. The finding of the Patent Office in a case where the record before the trial court is a mere repetition of the record in the Patent Office has been said to assume "well nigh dominating importance." *Globe-Union, Inc.* v. *Chicago Telephone Supply Co.* (C.C.A. 7, 1939) 103 F.2d 722, 41 USPQ 366; *Wilcox* v. *Coe* (D.C. D.C., 1940) 33 F. Supp. 714, 45 USPQ 547. Accordingly, it would seem that in a 35 U.S.C. 145 suit in which the trial court is given merely the plaintiff's interpretation of evidence adduced in the Patent Office the decision of the trial court should be truly "dominating."

If the reasoning of Chief Justice Wheat in *Rettmeyer* v. *Coe*, (D.C. D.C., 1940), 44 USPQ 640 and of *Luhring, J.* in *New Wrinkle Inc.* v. *Coe* (D.C. D.C., 1940) 31 F. Supp. 415, 45 USPQ 69, were given a new currency the appellants' suit would be subject to dismissal as being in reality an appeal from the decision of the Patent Office Board of Appeals and therefore within the sole jurisdiction of the United States Court of Customs and Patent Appeals. Judge Learned Hand, in *Sinko Tool and Manufacturing Company* v. *Automatic Devices Corporation* (C.C.A. 2, 1943), 136 F.2d 186, 57 USPQ 356, stated a contrary view as to jurisdiction but also recognized the appellate character of a R.S. 4915 suit in which no new evidence was adduced before the District Court. Since it was so established that a civil action in which no new evidence is adduced in the District Court has an appellate character the present appellants are in an indefensible position when they ask review of a decision of the Patent Office Board of Appeals on something less than the record before the Patent Office.

2. The absence of evidence supporting the appellants' argument that a paper barrel with a rubber end ring will have a novel and unexpected function would seem to preclude a reversal of the District Court's decision. The appellants' brief (pages 5-10) is devoted in large part to the argument that, unexpectedly, a paper, or fiber board, barrel having rubber end rings is distorted to a greater extent than barrels with metal or fiber rings but that the barrel with rubber rings recovers from the distortion without permanent injury; the barrels with metal or paper board rings, it is said, will be distorted to a lesser degree with the same impact but this lesser degree of distortion will result in a permanent rupture of the paper board of the barrel. This argument, however, is not based on any comparative tests or other evidence.

From the Board's comments (J.A. 14, first sentence) it appears that in the Patent Office the applicant filed an affidavit showing comparative tests of drum containers or barrels having metal "head" or end rings and those with rubber "head" rings. This affidavit did not, apparently, report tests on barrels with *fiber* end rings although the examiner's Final Rejection (J.A. 9) emphasized the fact that no new or unobvious result was obtained by the substitution of rubber for "fiberboard" in the "connecting," or end, ring. However, not even the comparative tests of metal and rubber appear in the present record.

Since an unexpected or unobvious superiority over a reference patent is urged, evidence as to comparative tests between the application and the reference is a "minimum requirement." *Blanchard, Jr.* v. *Ooms*, 80 App. D.C. 400, 153 F.2d 651; *In re John P. Swentzel*, 42 C.C.P.A. 719, 215 F.2d 272. As the court stated in *In re John P. Swentzel*, "No evidence of such tests is of record here, and we must look to the record, rather than to the briefs of counsel, for evidence of superiority."

3. If, as appellants urge (Appellants' Brief, 5, 6), a rubber end ring on a paper barrel provides a connection "which would *permit the distortion* of the barrel wall without breakage to a greater extent than was possible when the parts were connected by the metal and fiber board rings of the prior art" this is no more than would be expected from the resilient and flexible properties of rubber. It is within common experience that these properties are utilized in a large variety of bumpers and in rubber tires intended to absorb impact shocks. These properties and the resulting functions of rubber, in fact, are so well recognized that they have been the subject of judicial comment. In *Wilson-Western Sporting Goods Co.* v. *George E. Burnhart* (C.C.A. 9, 1936), 81 F.2d

108, the court held, "At this late day, it is not invention to assert that rubber, being flexible, will allow play at the joint between a shaft and a socket!" As long ago as 1908 the court in *New York Belting and Packing Co., Limited, et al.* v. *Sierer* (C.C.A. 2), 158 Fed. 819 stated at page 823, "The ordinary incident of elastic compounds is the capacity for expansion and compression. Employing this material in any known form of tile—interlocking or other form—involved no essentially novel use." In *United States Appliance Corporation* v. *Beauty Shop Supply Co., Inc.* (C.C.A. 9, 1941), 121 F.2d 149, the court dealt with the substitution of flexible rubber for another material as follows:

> "A consideration of these prior patents shows similar devices and it will be found that the patented device merely substitutes flexible rubber for other material used in the prior art to make a jacket. A substitution of one material with known characteristics for another material does not rise to the dignity of invention."

The present case provides no evidence of unexpected functions and advantages and no evidence of other circumstances which would establish the presence of invention in the claimed paper barrel. The absence of any comparison data between barrels with rubber end rings and barrels with fiber or metal end rings leaves unfounded appellants' suggestion (Appellants' Brief, page 10) that the claimed invention was the solution sought for many years. Appellants' reference on the same page to patents on paper barrels dated as far back as 1882 ignores the fact that the Bliss patent shows that the paper barrel structure here claimed was patented in 1932 (J.A. following page 17). Evidence is lacking that would bring the present case within the purview of the decisions cited in the appellants' brief (page 7). If appellants' barrel is an improvement, this is not shown. If appellants' barrel answers a long sought need, this need and the extent to which this need is answered are not apparent from anything of record.

## CONCLUSION

It is respectfully submitted that the appellants cannot prevail in this appeal since they presented no testimony at trial; that no evidence of record supports the appellants' assertion that a novel and unexpected function results from the substitution of rubber for fiber or metal as the material for a paper barrel end ring; that this substitution would be obvious to a person of ordinary skill in the art; and that for each of the aforesaid reasons the decision appealed from should be affirmed.

Respectfully submitted,

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ARTHUR H. BEHRENS,
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September, 1957.

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